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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Peter Kleinschmidt

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01/13/2006

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EXAMINER

COBANOGLU, DILEK B

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,217

Applicant(s)

KLEINSCHMIDT ET AL.

Examiner

Dilek B. Cobanoglu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the amendment filed 11/03/2005. Claims 1, 3, and 6 to 12 are pending. Claims 1 and 3 are amended. Claims 2, 4 and 5 are cancelled.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. The examiner is currently working to locate the originally filed priority documents and to have them scanned into the electronic image file wrapper (IFW) for viewing via PAIR.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3 and 6 to 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozen et al. (U.S. Patent No. 6,073,106) in view of Experton (U.S. Patent No. 5,995,965); as applied in the previous Office Action, further reasons are provided herein below.

A. As per claim 1, Rozen discloses a tele-health information system for a patient group, comprising:

- i. a server (Rozen et al.; col.5, lines 32-41) having access to a data base containing personal data (Rozen et al.; abstract and col.1, lines 11-16) and medical data (Rozen et al.; col.5, lines 31-32) of a patient belonging to a group of patients each patient having an authenticating access code uniquely allocated thereto (Rozen et al.; col.10, lines 19-35);
- ii. a variable data input device connectable to a plurality of location-variable data request stations of different types and having different data transmission systems associated therewith, for generating data requests and user requests to said server (Rozen et al.; abstract and col.8, lines 1-8);
- iii. an intelligent data output device connected to said server for producing a data output from said server adapted to a type of data request station making a data request to said server or adapted to a user request to said user (Rozen et al.; abstract and col.5, lines 31-41).

Rozen et al. fails to expressly teach the one of said data request stations comprising a mobile access communication device having an electronic chip in which the authenticating access code integrated for one of said patients is stored, per se, since it appears that Rozen et al is more directed to an identification card which stores participant's medical and identification information as well as service provider's web address and telephone number (Rozen et

al.; col.8, lines 28-33). However, this feature is well known in the art, as evidenced by Experton.

In particular, Experton discloses one of said data request stations (Experton's portable access device 100) comprising a mobile access communication device (Experton's card unit 100) having an electronic chip (Experton; col. 4, lines 19-21) in which the authenticating access code (Experton's access data 112) integrated for one of said patients is stored (in memory 104)-(see col.4, lines 8-26 and 38-50)

It would have been obvious to one having ordinary skill in the art at the time of the invention to have combined the identification card which stores participant's medical and identification information with the programmable microprocessor chip that is embedded in the card with the motivation of emergency medical personnel to quickly access a potentially large amount of medical data (Experton; col. 2, lines 26-31) and having memory and input/output units connected to the processor (Experton; col. 4, lines 15-19).

B. As per claim 3, Rozen discloses a tele-health information system as claimed in claim 1 said authenticating access code is a pin number (Rozen et al.; abstract and col.4, lines 66-67 and col. 5, lines 1-9)

C. Claims 6 to 12 have not been amended. As such, claims 6 to 12 are rejected for the same reasons given in the previous Office action and incorporated here.

Response to Arguments

5. Applicant's arguments filed 11/03/2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 11/03/2005.

6. At pages 4-9, Applicant makes the following arguments:

a. Applicant argues that it is not understood why 102(e) rejection was made instead of 102(b).

b. Applicant argues the Examiner's given motivation is too general and broad, and cites case law to support his position.

c. Applicant argues that Examiner must provide a specific motivation.

As per the first argument (argument a), the Examiner would like to state that at the time of the first action the Examiner tried to find electronic copies of the priority documents and discovered that they were not in the electronic file system; however the Examiner also recently received a copy of the Applicant's evidence indicating that the Office had received the foreign priority document. Based on the date of the foreign priority document, it is readily apparent that the applied Rozen reference is a 102(e) type document.

As per the second argument (argument b), the examiner would like to state that all of the motivations are taken from the applied references, as

specific citations from the reference have been stated after the motivations; therefore they are directly related to applied prior art.

7. In response to Applicant's Federal Circuit examples, the examiner would like to state respectfully that these examples are not pertinent to the issues at hand, because the motivations are taken directly from the references.

9. In response to Applicant's third argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

10. In response to Applicant's argument about the references found by the examiner do not rise the level of detail as required, Examiner believes that the applicant appears to ignore the level skill that is attributed to the ordinary artisan. In particular, Experton discloses connection types such as wireless links and gives a motivation of quickly accessing a potentially large amount of data using a readily and widely available communications link (Experton; col.2, lines 26-31 and col.4, lines 15-19). Applicant does not give any scientific or logical reason why such a motivation would not be sufficient for the combination of Rozen and Experton.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied prior art teach "Method and apparatus for generating and collecting a billing event object within an on-line network" 5,893,077 A, "Personal injury claim management system" 5,956,687 A, "On-line pharmacy automated refill system" 5,970,462 A, "Remote access medical image exchange system and methods of operation therefor" 6,006,191 A, "Interactive method and system for managing physical exams, diagnosis and treatment protocols in a health care practice" 6,047,259 A, "Systems, methods and computer program products for identifying unique and common legal requirements for a regulated activity among multiple legal jurisdictions" 6,064,968 A, "Destination website access and information gathering system" 6,148,331 A, "Method and system for managing wellness plans for a medical

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care practice" 6,208,974 B1, "Method and apparatus for the management of data files" 6,263,330 B1.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dilek B. Cobanoglu whose telephone number is 571-272-8295. The examiner can normally be reached on 8-4:30.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DBC

DBC
Art Unit 3626
01/09/2006


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER